IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **David R. Robins**   Confirmation No.: **2570**

Serial No.: **10/611,737**   Group Art Unit: **2625**

Filing Date: **July 1, 2003**   Examiner: **Allen H. Nguyen**

For: **HIGH SPEED DIGITAL IMAGE PRINTING SYSTEM**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPELLANT'S REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Appellant submits this Reply in response to the Examiner's Answer dated July 29, 2010 in connection with the above-identified application. This reply is being filed within two months of said answer.

Appellant persists in its appeal of all claims pending in the present case. Therefore, Appellant reiterates its request for reversal of (1) the rejections of claims 29-30, 36-37, 43-45, 47-51, and 54-56 under 35 U.S.C. § 102(b) as being anticipated by Barry et al, U.S. Patent No. 5,859,711 ("Barry"), (2) the rejections of claims 42, 46, and 53 under 35 U.S.C. § 103(a) as being unpatentable over Barry in view of Kito, U.S. Patent No. 6,628,899 ("Kito"), and (3) the rejections of claims 31 and 52 as being unpatentable over Barry in view of Nagasaka, U.S. Patent No. 5,333,246 ("Nagasaka").

Appellant respectfully submits that the Examiner's arguments in the Examiner's Answer fail to overcome Appellant's arguments for the reversal of the rejections of independent claims 29, 36, and 50 set forth in the Appeal Brief. Specifically, the Examiner errs in the Examiner's Answer by finding that Barry teaches "determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 29, and by finding that Barry teaches similar recitations of claims 36 and 50. For the reasons set forth below, Appellant requests that the Board reverse this finding by the Examiner, and reverse the

rejections of claims 29-30, 36-37, 43-45, 47-51, and 54-56 under 35 U.S.C. § 102(b) and the rejection of claims 31, 42, 46, 52, and 53 under 35 U.S.C. § 103(a).

1. Error in the Examiner's Answer

The Examiner errs in the Examiner's Answer by finding that Barry teaches "determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 29. Because claim 29 recites determining that the images in the subset "require image processing to meet a defined image parameter," the images in the subset do not yet meet that defined image parameter when the determining of claim 29 is performed.

As Appellant noted in the Appeal Brief, Barry's Fig. 12 shows that a print job 352 with three color pages and three color images is sent through a virtual job router 354. The virtual job router 354 separates the three black and white pages into a black and white print job 356 and the three color pages into a color print job 358. The black and white print job 356 is sent to be printed by a black and white printer, and the color print job 358 is sent to be printed by a color printer. Thus, Barry teaches determining whether pages in a print job are black and white or whether the pages in the print job are color, separating the black and white pages from the color pages, sending the black and white pages to a black and white printer, and sending the color pages to a color printer.

The Examiner's Answer explicitly states that the Examiner reads either the color parameter of Barry's print job or the black and white parameter of Barry's print job as being the defined image parameter of claim 29. Answer, pages 13-14. Substituting Barry's parameters of "color" or "black and white" pages for the term "image parameter" would render claim 29 to read "determining a subset of the plurality of [pages] which require image processing to [be a color page or a black and white page]." Even assuming, *arguendo*, that Barry's parameters of color pages or black and white pages can be read on the recited image parameter, Barry still fails to teach the determining recited by claim 29. Barry clearly does not teach that any of the pages in print job 352, color or black and white, require image processing to be color pages or black and white pages. The pages in print job 352 already are either color pages or black and white pages. The only determining that Barry does is to determine *whether* the pages in print job 352 already are color pages or black and white pages. In contrast, claim 29, as read by the Examiner,

recites, "determining a subset of the plurality of [pages] which require image processing to [be a color page or a black and white page]." Nothing in Barry teaches or suggests that the pages in print job 352 requires image processing to be color pages or to be black and white pages.

For the foregoing reasons, Appellant respectfully submits that the Examiner erred in finding that Barry teaches "determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 29. Appellant respectfully requests reversal of the Examiner's finding.

The Examiner errs in the Examiner's Answer by finding that Barry teaches a "processing means for determining a subset of the plurality of digital images which require image processing to meet an image parameter," as recited by claim 36. Appellant submits that Barry fails to teach this recitation of claim 36 for at least the reasons discussed above, namely, that Barry fails to teach "determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 29. Thus, Appellant respectfully requests reversal of the Examiner's finding that Barry teaches a "processing means for determining a subset of the plurality of digital images which require image processing to meet an image parameter," as recited by claim 36.

The Examiner errs in the Examiner's Answer by finding that Barry teaches a "computer-readable storage medium comprising...instructions for...determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 50. Appellant submits that Barry fails to teach this recitation of claim 36 for at least the reasons discussed above, namely, that Barry fails to teach "determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 29. Thus, Appellant respectfully requests reversal of the Examiner's finding that Barry teaches a "computer-readable storage medium comprising...instructions for...determining a subset of the plurality of digital images which require image processing to meet a defined image parameter," as recited by claim 50.

2. Conclusion

Appellant respectfully requests, for the reasons set forth in the Appeal Brief, reversal of (1) the rejections of claims 29-30, 36-37, 43-45, 47-51, and 54-56 under 35 U.S.C. § 102(b) as being anticipated by Barry, (2) the rejections of claims 42, 46, and 53 under 35 U.S.C. § 103(a)

as being unpatentable over Barry in view of Kito, and (3) the rejections of claims 31 and 52 as being unpatentable over Barry in view of Nagasaka. As to the arguments addressed in the Examiner's Answer, Appellant submits that the Examiner errs by finding that Barry's parameters of "color" pages or "black and white" pages read on the term "image parameter" of claims 29, 36, and 50. As to the arguments which are not addressed in the Examiner's Answer, Appellant reasserts that claims 29-31, 36, 37, 42-56 are patentable over the cited references.

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/Jon M. Isaacson/

Jon M. Isaacson
Registration No. 60,436

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439